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09/710,366	11/10/2000	Robert E. Haines	10003235-1	5518

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/710,366

**Applicant(s)**

HAINES ET AL.

**Examiner**

Mark Fadok

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 25 and 26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 2/24/2004, which was received 6/17/2004. Acknowledgement is made to the amendment to claims 1,10,18 and 21 and the addition of claims 25 and 26, leaving claims 1-26 as pending in the instant application. The applicant's amendment and arguments have been carefully considered, but were not found to be persuasive. Therefore, the previous rejection, modified as necessitated by amendment, is restated below:

***Election/Restrictions***

Newly submitted claim 25 and 26 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 25 contains clearly divergent subject matter.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25 and 26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Official Notice Traverse***

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 3625

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant claims an extended data interface (EDI). Since the term was not described in the specification the examiner looked to Microsoft's Computer dictionary for a definition, which described (EDI) "Electronic data interchange" as a standard for exchanging bundles. This definition did not seem to be consistent with the applicant's EDI. The examiner also searched the web and could not find a definition of the term, for this reason the examiner for the purpose of examination will define the term (EDI) as a printer cable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 2002/0065950) and further in view of Kageyama (6,333,790).**

**In regards to claim 1**, Katz discloses a consumable order assistance system for computer peripheral devices, comprising:

a personal computer having a web browser and a messaging system (page 5, para 69);

Katz teaches a messaging system (page 5, para 69), but does not specifically mention that the peripheral device has an embedded web server. Kageyama teaches a server that is embedded in the peripheral device (FIG 2 and col 2, lines 25-35). It would have been obvious to a person having ordinary skill in the art to include in Katz the embedded web server as taught by Kageyama, because this would permit multiple printers with different functionality to report to one computer without having to provide control functionality at the computer level, thus reducing the amount of software and control the computer is required to maintain.

a communication link signal coupling the personal computer with a seller of a consumable for the computer peripheral device via the web browser (page 5, para 69);  
and

a consumable order assistance computer program provided on the personal computer (page 8, para 100, Peripheral interface agent (PIA)) and

configured to receive a notification from the computer peripheral device via the messaging system of a need to order a consumable (page 8, para 100),

alert a user of the personal computer of the notification (page 5, para 69), and  
provide an order location to the user for the consumable (page 5, para 69).

wherein the consumable order assistance system is configured for multiple unique functionality levels to provide consumable order assistance when ordering the consumable, the multiple unique functionality levels being configured to be at a level that is required by a customer. Katz teaches ordering consumables but does not specifically mention that different levels of order assistance are configurable into the system. Kageyama teaches different levels of functionality configured as required by a customer (col 13 and 14). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Katz the ability to vary the level of functionality as taught by Kageyama, because it have been well known in the art that different situations and customers require different levels of functionality either due to level of experience or financial reason. Offering the different levels of functionality would further allow the customer to choose how much service they would like to purchase saving the client money and giving the seller the ability to sell other devices., and

wherein the embedded web server is configured to push information from the computer peripheral device to the personal computer.

**Claim 2-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 2002/0065950) in view of Kageyama (6,333,790) and further in view of Official Notice).**

**In regards to claim 2,** Katz teaches wherein the consumable order assistance computer program is further configured to collect a series of notifications and

summarize the series of notifications for one or more computer peripheral devices (page 5, management of devices). Applicant may, however, may argue that the system of Katz does not specifically mention that there is a summary of the notifications. It was old and well known in the art at the time of the invention to collect and list notifications. It would have been obvious to a person having ordinary skill in the art to include in Katz listing a summary of notices, because this would improve the system of Katz by placing the requirements of paper toner and other supplies along with software needs (page 5, para 69) all in one convenient list for purchase which is commonly referred to as a shopping cart or invoice.

**In regards to claim 3,** Katz teaches wherein the consumable order assistance computer program consolidates a plurality of notifications from the at least one computer peripheral device (see response to claim 2).

**In regards to claim 4,** Katz teaches wherein the consumable order assistance computer program is further configured to request identification from a user to verify authorization of the user to submit an order (page 3, para 32, interactive processing of transaction, locate subscriber account). Applicant may, however, argue that the system of Katz does not specifically mention that the user is prompted for identification to authorize a purchase. It was old and well known in the art at the time of the invention to identify and authorize a user before a transaction is completed. It would have been obvious to a person having ordinary skill in the art to include in Katz the identification



and authorization of a user, because if this was not done then an unauthorized transaction might take place which the user may refuse to pay for, thus having the company loose money by providing product that was not authorized.

**In regards to claim 5**, Katz teaches wherein the consumable order assistance computer program is further configured to request at least one level of authorization from a user before sending an order via the communication link to a reseller of the consumable (see response to claim 4 and page 29, para 667, present pages to an interactive user and gather data from him or her).

**In regards to claim 6**, Katz teaches wherein the consumable order assistance computer program is further configured to request at least one level of authorization from a user before sending an order via the communication link to a reseller of the consumable (see response to claims 4 and 5)

**In regards to claim 7**, Katz teaches wherein the consumable order assistance computer program is further configured to prompt a customer user for authorization information (see response to claims 4-6).

**In regards to claim 8**, Katz teaches wherein the communication link comprises an electronic communication link that enables the consumable order assistance computer program to submit an e-mail order (page 6, para 77). Applicant may argue,

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however that Katz does not specifically mention that the order is being submitted via e-mail. It was old and well known at the time of the invention to use e-mail to communicate purchase orders. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Katz using e-mail to submit an order, because this would offer the user another means for conducting a transaction which would allow the user to make an order if other forms of e-commerce were not available, thus assuring to some degree that the sale was not lost.

**In regards to claim 9**, Katz teaches an e-commerce system for ordering peripheral device components, but does not specifically mention that the ordering is done using a facsimile. It was old and well known in the art at the time of the invention to use facsimile machines to place orders. It would have been obvious to a person having ordinary skill in the art to include in Katz placing orders by facsimile, because this would give people not connected to the Internet the capability to order the parts, thus saving a sale by providing the consumer a means to order the required parts.

**In regards to claim 10**, Katz discloses a computer-implemented system which implements a program in which consumable components of computer peripheral devices are replenished, the system comprising:

a notification system that alerts a user of a personal computer that they need to order a consumable for a computer peripheral device associated with the personal computer, the computer peripheral device having an embedded web serve, and the

notification system being provided in the embedded web server (see response to claim 1);

a facilitation system that provides a communication link with a reseller of the consumable; and

at least one from a list of a consolidation system for consolidating a plurality of orders,

an authorization system for confirming that a user is authorized to place an order for the consumable, and

an order assistance system that places an order for the consumable (see response to claims 1-9).

wherein the computer-implemented system is configured to establish multiple unique functionality levels to provide consumable order assistance when ordering the consumable, the multiple unique functionality levels being configured to be at a level that is required by a consumer (see response to claim 1).

**In regards to claim 11,** Katz teaches ordering device components over the Internet, but does not specifically mention that the items presented for order have a part number. It was old and well known at the time of the invention to identify parts to be ordered using a part number. It would have been obvious to a person of ordinary skill in the art to include in Katz providing a part number, because this is a notoriously well known way of identifying parts and would provide a means for assuring that the correct part was ordered.

**In regards to claim 12**, Katz teaches wherein the notification system comprises a messaging system within an embedded web server of a computer peripheral device and a messaging system within a personal computer (page 5, para 67).

**In regards to claim 13**, Katz teaches wherein the personal computer further comprises a browser, and the messaging system comprises

an e-mail application (page 6, para 77),

Katz teaches sending information to a user to purchase an item (para 67,68 and 87, prompting the user to conduct a transaction), but does not specifically mention that the information is provided by email. It was old and well known at the time of the invention to use email to provide information such as alerts. It would have been obvious to person of ordinary skill in the art to include in Katz emailing information to the user, because this would provide an effective means for sending information and not interrupting the user who may be working on something else and not be pleased with a sudden interruption by some manufacturer trying to sell a consumable.

**In regards to claim 14**, Katz teaches wherein the e-mail notification identifies the consumable by a part number (see response to claims 11 and 13).

**In regards to claim 15**, Katz teaches wherein the system comprises the consolidation system configured to aggregate a plurality of notifications for one or more computer peripheral devices (see response to claim 2).

**In regards to claim 16**, Katz teaches wherein the system comprises the authorization system configured to request authorization from a user prior to automatically submitting an order for the consumable to a reseller of the consumable (see response to claims 4 and 5).

**In regards to claim 17**, Katz teaches wherein the system comprises the order assistance system configured to automatically submit an order for the consumable in response to receiving a notification that a consumable needs to be ordered (page 28, para 618, non-interactive).

**In regards to claim 18**, Katz discloses a method of providing order assistance, comprising:

- providing a computer peripheral device,
- a personal computer having a communication link with a reseller of a consumable, and
- a messaging system extending between the computer peripheral device and the personal computer;
- detecting a need to replenish a consumable at the computer peripheral device;

notifying a user at the personal computer of the need to replenish the consumable;

providing an order address location to a user for a reseller that sells the consumable; and

placing an order for the consumable with the reseller using the personal computer (see response to 1-17 and e-commerce URL).

configuring the computer peripheral device and the personal computer to operate in at least one of multiple unique functionality levels to provide consumable order assistance when ordering the consumable, the multiple unique functionality levels being configured to be at a level that is desired by the customer (see response to claim 1).

**In regards to claim 19**, Katz teaches wherein placing the order comprises automatically placing the order for the consumable in response to notifying the user (page 5, para 68).

**In regards to claim 20**, Katz teaches wherein, prior to placing an order, querying a user to authorize placing the order with an identified reseller (see response to claims 4,5 and 6).

**In regards to claim 21**, Katz discloses a consumable order assistance system for computer peripheral devices, comprising:

a personal computer having a web browser and a messaging system (see response to claim 1);

at least one computer peripheral device having an embedded web server (see response to claim 1) and a messaging system (see response to claim 1);

a bi-directional communication link signal coupling the personal computer with a seller of a consumable for the computer peripheral device via the web browser (page 6, para 78),

the bi-directional communication link configured to enable a user to interact with the computer peripheral device to obtain information on a consumable for one computer peripheral device including at least one of consumable levels, media levels and types, warnings, notifications, job assurance, and printer capabilities (page 6, para 78 and page 5, para 67);

a consumable order assistance computer program provided on the personal computer and configured to receive a notification from the computer peripheral device via the messaging system of a need to order a consumable, alert a user of the personal computer of the notification, and provide an order location to the user for the consumable (see response to claims 1-20); and

a server communicating with one of the personal computer and the at least one computer peripheral device (page 5, para 67) and

including a centralized management database having information pulled from the Internet and comprising at least one of consumable part numbers, alternative

consumable part numbers, and information for selecting a reseller (PIA web server and response to claim 11).

wherein the consumable order assistance system is configured for multiple unique functionality levels to provide consumable order assistance when ordering the consumable, the multiple unique functionality levels being configured to be at a level that is required by a customer, and wherein the embedded web server is configured to push information from the computer peripheral device to the personal computer (see response to claim 1).

**In regards to claim 22**, Katz teaches wherein at least one of the server and the at least one computer peripheral device proactively generates a warning to a user at the personal computer comprising information on an upcoming issue regarding maintenance and operation of a selected computer peripheral device (page 8, para 103, and para "low ink").

**In regards to claim 23**, Katz teaches communicating information, but does not specifically mention that the information is transmitted over an extended data interface. The use of an extended data interface to transmit data was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in Katz transferring information over an extended data interface, because this is a very effective means of transferring information and could be used if alternative means were not available.

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**In regards to claim 24**, Katz teaches wherein the centralized management database is configured for interaction with a maintainer at the personal computer to enable determination of when to replace a consumable as well as at least one of what consumable to replace, alternative parts for the associated peripheral device, issue urgency, proactive warning of one or more next issues, computer peripheral device location, owner/contact information, computer peripheral device model information, and impending maintenance notification (see response to claim 22, PIA/PIA Web server).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-24 on the merits have been considered, but are moot in view of the new ground(s) of rejection.

In regards to applicant's argument concerning the use of the phrase "Extended Data Interface" (EDI) to mean "Electronic Data Interchange" (EDI). The examiner did not state that a definition could not be found for Electronic Data Interchange, rather a definition to the repugnant use of EDI being referred to as "Extended Data Interface" could not be found. The rejection stands and must be responded to in the next office action.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

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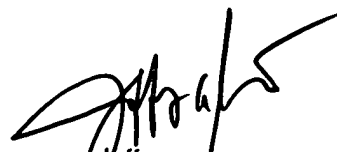
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Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent Examiner



Jeffrey A. Smith  
Primary Examiner